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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,169	05/14/2001	Howard M. Welch	03768/09379	8922 17
7590	10/03/2003			
Neil C. Jones Nelson Mullins Riley & Scarborough Keenan Building, Third Floor 1330 Lady Street Columbia, SC 29201			EXAMINER AFTERGUT, JEFF H	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,169

Applicant(s)

WELCH ET AL.

Examiner

Jeff H. Aftergut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-22 and 25-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In each of the independent claims in the above noted listing of claims, the applicant recites that the device of method included a series of chill rollers “consisting essentially of a first chill roller and a second chill roller”. The applicant is advised that the original disclosure did disclose that the operation of chilling the extruded filaments could be practiced with only two chill rollers, however the original disclosure did not elaborate as to what was meant to have been included and/or excluded as to materially effect the method or apparatus by the language “consisting essentially of”. As a result, the presentation of the language has created a “new matter” problem, as applicant did not have in his/her possession the specific components which could be included and/or excluded from the operation which would have materially effected the operation and/or apparatus.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-22 and 25-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of the independent claims, the applicant has amended the claims to recite a series of chill rollers “consisting essentially of a first chill roller and a second chill roller”. The applicant is advised that the language “consisting essentially of” is not deemed to be clear and concise. It is not clear from the original disclosure what could be included other than the two chill rollers which did not materially effect the overall operation and/or apparatus. The applicant provided no guidelines in the original disclosure as to what could or could not be included in the cooling arrangement. Because the original disclosure did not define what was meant by “consisting essentially of” the exact scope of the claim cannot be ascertained.

Election/Restrictions

5. Newly submitted claim 30 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 30 is directed to a species for chilling the extruded filaments which was independent from the species described wherein only two chill rollers were employed, see the specification at pages 13 and 14.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 30 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-22 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canadian Patent 2248575 in view of PCT WO 92/16366 and any one of Pomplun et al (newly cited), Bunnelle et al (newly cited) or De Geest et al (newly cited).

Canadian Patent '575 and PCT '366 are cited for the same reasons as previously submitted. The applicant is referred to the previous actions for a complete discussion of the same. The references failed to teach that those skilled in the art at the time the invention was made would have only incorporated two chill rollers. It should be noted as addressed above that it is not clear whether the claimed method and apparatus requires just two chill rollers in the operation or not (i.e. what additional apparatus could be included in the claim which states "consisting essentially of" the rollers is not known). However, it would appear that it was applicant's intent by the amended language to recite that the operation and device consisted of two chill rollers only.

The references to any one of Pomplun et al, Bunnelle et al, or De Geest et al each suggested that it was known per se to incorporate only two chill rollers to cool an extruded material in an extrusion operation. Applicant is more specifically referred to Pomplun et al at

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column 8, lines 10-13, chill rollers 92 and 94 which chilled and extruded elastic material exiting an extrusion die 90. The reference to Bunnelle et al suggested the use of two chill rollers 15, 16 which were used to chill an extruded elastic material 13 exiting an extrusion device having nozzle 12, see column 5, lines 55-column 6, line 2. The reference to DeGeest suggested that those skilled in the art would have employed two quenching rollers 41 and 43 to chill an extruded film in the operation of extruding. Clearly, rather than using multiple numbers of chill rollers, those skilled in the art at the time the invention was made would have readily appreciated that the operation would have been successfully practiced with only two chill rollers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ only two chill rollers in the operation of Canadian Patent '575 as suggested by any one of Pomplun et al, Bunnelle et al or De Geest et al wherein the extruded material was applied upon the chill rollers in a canted direction as suggested by PCT '366.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 7 further taken with any one of Japanese Patent 54-82424, Wirz, or Ditzler for the same reasons as presented in paper no. 12, paragraph 3.

Response to Arguments

9. Applicant's arguments with respect to claims 1-22, 25-29 have been considered but are moot in view of the new ground(s) of rejection.

The applicant essentially argues that there is no reason to incorporate a single pair of chill rollers in the claimed operation. The applicant is advised, however, that the newly cited references all suggested that one skilled in the art of extrusion would have known to incorporate

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a pair of chill rollers in the operation. The applicant is additionally advised that there is no mentioned unexpected benefit for the incorporation of the chill roller pair in the operation in the disclosure, the use of the roller pair is merely mentioned as an alternative. As set forth in MPEP 2111.03, there is a discussion of the transitional phrase “consisting essentially of”. The applicant is advised that as directed by the MPEP 2111.03:

“For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.””

Additionally, the applicant is advised that the applicant has the burden to establish that there is some unexpected benefit imparted by the excluded components of the claimed subject matter.

Again applicant is referred to MPEP 2111.03:

“If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989)”

The applicant is advised that, here, one skilled in the art would have readily appreciated that two rollers for chilling the extruded material would have been suitable in the operation rather than the use of multiple roller pairs as was performed by the Canadian Patent ‘575. No claims are allowed.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 703-308-2069. The examiner can normally be reached on Monday-Friday 6:30-3:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jeff H. Aftergut
Primary Examiner
Art Unit 1733

JHA
September 23, 2003